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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,311	01/04/2002	Takehisa Kato	P 290460 T2TYA-97S0351-1C	2529
7590 07/01/2005 Pillsbury Winthrop LLP Intellectual Property Group 1600 Tysons Boulevard McLean, VA 22102			EXAMINER CALLAHAN, PAUL E	
			ART UNIT 2137	PAPER NUMBER

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,311

Applicant(s)

KATO ET AL.

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36 and 41-47 is/are allowed.
- 6) ☒ Claim(s) 23, 24, 26-28, 30-32, 34, 35, 37, 39 and 40 is/are rejected.
- 7) ☒ Claim(s) 25, 29, 33, 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/883,337.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date PR
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-22 were originally pending in this application but have been cancelled by preliminary amendment in favor of new claims 23-47. Therefore claims 23-47 are pending and have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 32, 34, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain the limitation of recording at least part of a p number of keys in a secret area. As written, the limitation could mean either that the act of recording is conducted in a secure room or building, or that the physical area into which the information is recorded is a secure location. Therefor the claim language is unclear to the extent that it does not adequately appraise one of ordinary skill in the art as to the scope of the claim.

Claim 33 is dependent on claim 32 and is thereby rejected on the same basis.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claims 26 and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed towards an arrangement of data, i.e., a data structure, arranged on a memory medium. No language is found in the claim directed towards the data structure causing a change in the configuration of a computing device when read out, or similar language. Therefore the claim is directed towards non-statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 23, 24, 26, and 30 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Haas et al. US 5,719,938.

As for claim 23, Haas teaches an enciphering method (abstract) comprising the steps of: keeping a plurality of second keys (col. 1 line 44 through col. 2 line 2, col. 3 lines 23-46); enciphering data with a first key (col. 1 lines 42-44, col. 3 lines 23-46); and enciphering said first key with a p number of second keys where p is an integer greater than or equal to two, of the kept plurality of second keys to obtain a p number of enciphered first keys respectively (col. 1 line 44 through col. 2 line 2, col. 3 lines 23-46).

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As for claim 24, Haas teaches an enciphering method according to claim 23, wherein said data includes at Least one of key information, documents, sound, images, and programs (electronically stored documents col. 1 lines 5-10).

As for claim 26, Haas teaches a recording medium having information items recorded thereon, said information items comprising: first information obtained by enciphering data with a first key; and second information composed of a p number of enciphered first keys, where p is an integer greater than or equal to two, obtained by enciphering said first key with a p number of second keys respectively, and where said second information composed of the p number of enciphered first keys is recorded in a key recording area of said recording medium. (col. 1 lines 5-10, 42-44, col. 3 lines 23-46, col. 2 line 66 through col. 3 line 4)

As for claim 30, Haas teaches a specific "key recording" area ("user locker") (col. 1 lines 50-65).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 27, 28, 31, 37, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas.

As per claim 28, Haas teaches a recording medium manufacturing method comprising, keeping a plurality of second keys (col. 1 line 44 through col. 2 line 2, col. 3 lines 23-46); obtaining first information composed of enciphered data obtained by enciphering data with a first key (col. 1 lines 42-44, col. 3 lines 23-46); (col. 1 lines 42-44, col. 3 lines 23-46); obtaining second information composed of a p number of enciphered first keys, where p is an integer greater than or equal to two, obtained by enciphering said first key with a p number of second keys respectively (col. 1 line 44 through col. 2 line 2, col. 3 lines 23-46). Haas does not teach recording said first and second information on the same recording medium, however Official Notice may be taken that such a step is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Haas. The motive to make this motivation is found in Haas at least at (col. 1 lines 50-65) where such storage is taught as occurring anywhere within the network, most particularly at the "user's locker". This would be advantageous since this allows for such joint storage under the user's control.

As for claims 27 and 31, Haas does not teach the use of removable media. However official Notice may be taken that the use of such storage is a step that is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Haas. Motive to make this combination is found in Haas at least at col. 1 lines 50-65 where such storage is taught as occurring anywhere within the network, most particularly at the "user's locker". Therefore the use of removable media would allow a user access to the system from anywhere in the network.

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As for claims 37, 39, and 40, Haas teaches keeping a plurality of second keys (col. 1 line 44 through col. 2 line 2, col. 3 lines 23-46); enciphering data with a first key (col. 1 lines 42-44, col. 3 lines 23-46); (col. 1 lines 42-44, col. 3 lines 23-46); enciphering said first key with a p number of second keys, where p is an integer greater than or equal to two, of the kept plurality of second keys to obtain a p number of enciphered first keys and recording the first keys on the medium, respectively (col. 1 line 44 through col. 2 line 2, col. 3 lines 23-46). Haas does not teach recording the information on a removable recording medium to be distributed to a user, however Official Notice may be taken that such a step is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Haas. The motive to make this motivation is found in Haas at least at (col. 1 lines 50-65) where such storage is taught as occurring anywhere within the network, most particularly at the "user's locker". Therefore distribution of the information to the user by recording on a medium to be distributed to the user would be advantageous since this allows for such storage at any point in the network where the user has access, and such storage is under the user's control.

Allowable Subject Matter

10. Claims 36 and 41-47 are allowed.

11. Claims 25, 29, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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12. Claim 33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent document teaches features pertinent to the claimed invention:

Sprague et al. 5,247,575

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

6-23-05

